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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,116	07/26/2001	Bruce E. Price	RGP-0062	8624

23413 7590 10/25/2002

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 10/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/916,116	Applicant(s) PRICE ET AL.	
	Examiner Victor S Chang	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 20-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4,5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-19, drawn to a foam cushion tape, classified in class 428, subclass 304.4.
- II. Claims 20-33, drawn to a method for the manufacture of foam cushion tapes, classified in class 156, subclass 60+.

The inventions are distinct, each from the other because:

2. Inventions Group II and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make other and materially product such as thermal insulation tape.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Leah Reimer on 10/17/2002 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-19. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 20-33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' admission^s either individually, or in view of Birchall et al. (US 3839078).

For claims 1-3, Applicants appear to admit in the Specification that the prior art teaches a flexible compressible foam layer adhered to one side of a reinforcing film, with an adhesive disposed on the opposite side of the film. An adhesive layer is furthermore disposed on the outside of the foam layer. The tapes are typically made in the thickness of 15 to 60 mil (pages 1-2, bridging paragraph). Further, Applicants appear to admit that in the prior art the cushioning foam layer (polyethylene, ethylvinyl acetate, polyvinyl chloride, or polyurethane) is laminated to one side of a PET film, and a second adhesive layer is disposed between the PET film and a release layer (page 2, 2nd paragraph). It is noted that the admitted prior lacks specific teaching of including an "anchoring" layer between the reinforcing layer and the foam layer. However, the Examiner takes Official notice that including an anchor or tie layer, such as the polyvinylidene chloride, polyurethane, etc. in a laminated polymeric structure, which can

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include such structure as a foam layer, is old and well known. Alternatively, Birchall's invention is directed to ^{to} method of coating substrates, and Birchall teaches that it has been a common practice to coat a surface of a film substrate with one or more adhesion promoting layers which adhere to the film substrate and to which the superstrate readily adheres. Such intermediate coating layers are often referred to as 'anchor' coatings and are derived, for example, from an isocyanate-ended polyurethane resin, a phenol-formaldehyde resin or a vinylidene chloride - alkyl acrylate copolymer resin (column 22, lines 5 to 14). As such, it would have been obvious to one of ordinary skill in the art to modify Applicants' admitted prior arts with an anchor layer, such as a polyvinylidene chloride layer, between the reinforcing film substrate and the polyurethane foam layer, motivated by the desire to improve the adhesion between the laminate^l layers.

For claims 4-6, it is believed that the polyurethane foams used in flexographic printing are inherently open-celled; and polyethylene terephthalate, polybutylene terephthalate, etc. are commonly available reinforcing backing films.

Regarding claim 7, it is believed that coextrusion of a multi-layer film is conventional and well-known.

For claims 8-12, it is believed that acid etching a polymer surface for improved adhesion, applying a primer layer between an adhesive layer and a foam substrate layer, and attach a release layer made of a release coating, an intermediate layer, and a liner to protect the adhesive layer are each common and well-known.

For claims 13-19, the claims are substantially within the same scope as claims 1-12, and as such are rejected for the reasons as set forth above.

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7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition, the following references are cited of interest for making polymer laminates with anchor layer:

US 3931450 to Patton, Jr. et al.

US 4360562 to Endo et al.

US 4616044 to Fesman

US 5037700 to Davis

US 5726001 to Eichorst

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC
VSC
October 21, 2002

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1300~~
1700

Daniel Zinker